

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Haws, et al.
U.S. Patent Serial No.: 09/397,481
Filing Date: September 16, 1999
Examiner: A Michael Chambers
Art Unit: 2162
Title: METHOD AND APPARATUS FOR COOLING WITH A
PHASE CHANGE MATERIAL AND HEAT PIPES

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre- Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

In the prosecution of the present Application, the Final Office Action's rejections and assertions contain a clear error of law due to a failure to establish *prima facie* rejections in a Final Office Action. In a Final Office Action of July 5, 2005, Claims 1-6, 13, and 24-36 were rejected under 35 U.S.C. §102 as being anticipated over U.S. Patent No. 4,976,308 to *Faghri*, and Claims 4-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Faghri*. However, as described in further detail below, the Final Office Action failed to set forth a *prima facie* rejection of the claims.

As described more fully on pages 8-10 of Applicants' Response to the Final Office Action submitted on September 6, 2005, *Faghri* does not disclose that the heat pipes are "disposed at least substantially within the chamber and disposed within the material of said housing and operative to facilitate heat distribution within the material of said housing." In their Response, Applicants amended the claims to recite that the heat pipes are "disposed at least substantially within the chamber" The Final Office Action's response to this amendment was an assertion that such disposition is clearly shown in Figure 3 of *Faghri*, and the Final Office Action's response to Applicants' remarks regarding the claimed heat transfer characteristics is that the above disposition of the heat pipes is met by *Faghri*. Applicants respectfully submit that the above position taken in the Final Office Action is incorrect, as described below.¹

As clearly shown in Figure 3 of *Faghri*, the heat pipes 22 have a portion within container 12 (referred to as "housing 12" in the Final Office Action) and a portion external to container 12. The Office Action does not identify what it contends meets the claimed "chamber" limitation, but the language of Claim 1 is clear that the "housing has a chamber therein." Thus, Applicants respectfully submit, contrary to the statement in the Office Action, that heat pipes 22 are not disposed at least substantially within the chamber [which is disposed within the housing]. With respect to the heat transfer characteristics, the Office Action appears to have relied on the mistaken assumption that the claimed heat pipe disposition was met, but as demonstrated above it was not. As previously discussed in Applicants' Response to the Final Office Action, the heat pipes of *Faghri* function primarily to transfer heat between two regions respectively located inside and outside of the housing 12, rather than to transfer heat within the material of the housing as recited by Applicants'

¹ Applicants note a mistake in their Response to the Final Office Action. The sentence on line 13 of paragraph 4 of page 8 should state: "FIGURE 5 also clearly illustrates that the majority portion of the heat pipe 22 is not disclosed within cylindrical housing 12."

Claim 1. Additionally, Applicants have shown that *Faghri* does not disclose, teach, or suggest analogous limitations in Independent Claims 14 and 27. Applicants respectfully submit that the rejection of Claim 1 in view of *Faghri* is "clear error" as referred to in the July 12, 2005 Official Gazette Notice regarding New Pre-Appeal Brief Conference Pilot Program and respectfully request its withdrawal. For analogous reasons, Applicants submit that the rejections of Independent Claims 14 and 27 are also clear error.

In an Advisory Action mailed October 5, 2005, the Action's only response to these above remarks was that the "deposition of theat [sic] pipes 22 of Faghri (4,976,308) are ' . . . at least substantially within the chamber and disposed . . . ' within the material of the housing 12. This deposition is clearly shown in Figure 3. The chamber includes phase change porous heat absorbing material." As Applicants stated in their Response to the Final Office Action, however, the PTO still has not identified which item of Figure 3 it contends meets the claimed "chamber" limitation of Applicants' Claim 1. Claim 1 clearly recites "a housing has a chamber therein" and neither the Final Office Action nor the Advisory Action identifies where in the housing the chamber is found. It is noted that the PTO cannot identify this limitation in *Faghri* because it does not disclose pipes " . . . at least substantially within the chamber" Therefore, the advisory action fails to establish a *prima facie* rejection of Applicants' claims.

As a *prima facie* rejection has not been established against Independent Claims 1, 14, and 27, Applicants respectfully requests a finding of allowance of Claims 1, 14, and 27 and the Claims depending therefrom.

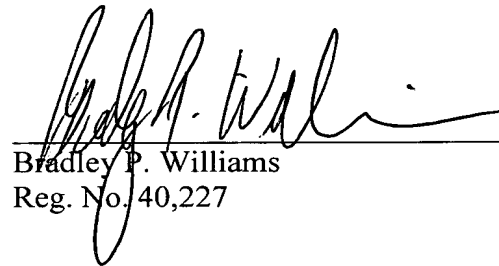
CONCLUSION

For the foregoing reasons, Applicants requests that application be allowed on the existing Claims. To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

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November 7, 2005

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